The opinion in support of the decision being entered today
was **not** written for publication in and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL J. GREDEN, ALEXANDER CASTRO, ALEX A. SIMONS, SCOTT A. SMITH, SUSAN P. SCHEER, and SE-WAI LEE.

Appeal No. 2006-1535
Application No. 09/584,232

ON BRIEF

Before LEVY, NAPPI and FETTING **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1 through 27, which constitute all the claims in the application. For the reasons stated *infra* we affirm the examiner's rejection of these claims, however as our rationale differs from that applied by the examiner we designate this decision as containing a new grounds of rejection under 37 CFR § 41.50(b).

Invention

The invention relates to a system and method to match a buyer with sellers or service providers which meet the buyer's criteria. See page 3 of appellants' specification.

Claims 1 is representative of the invention and reproduced below:

> 1. A computer implemented method for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions:
>
> providing the buyer with an interactive environment having information relating to the products or services offered by the agents;
>
> creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment;
>
> comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer; and
>
> automatically providing the identity of the suitable buyer to the suitable agent without action from the agent.

References

The references relied upon by the examiner are:

Burge	6,014,638	Jan. 11, 2000
Rizzo	6,470,338	Oct. 22, 2002

Rejection at Issue

Claims 1 through 27 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Burge in view of Rizzo. The examiner's rejection is set forth on pages 2 through 8 of the final rejection dated March 17, 2005. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 1 through 27. However, as our rationale differs from that set forth by the examiner we designate the affirmance as a new grounds of rejection.

Appellants argue, on pages 5 and 6 of the brief, "Burge merely displays certain items to the buyer based on the buyer's past preferences. No seller's criteria are used to match a buyer to a seller and provide the seller the buyer's identify. Burge does not provide the identity of a suitable buyer to a suitable agent." Further, on pages 8 and 9 of the brief, appellants state:

> Rizzo teaches a computerized method for matching potential clients with professional services providers which meet the buyer's specified criteria. Specifically, Rizzo's system is set up for a client in need of attorney services. Hence, when the data entered by the client is sent out to one or more suitable attorneys only part of the client's information is provided. **The client's identity that would allow direct contact (name, email and phone number) is not provided (Figure 1 a, step 270). In order to retrieve the client's identity the attorney must manually go to a website and request to retrieve it (Figure 1 a, step 290).** Clearly, as indicated in the cited paragraph above, Rizzo does not automatically provide the client's identity to the attorney without the need for the

> attorney to perform manual actions. **This is intentional so as to provide a means for the attorney to preclude conflicts in representing clients.** (emphasis original).

Appellants present similar arguments on pages 3 and 4 of the reply brief.

On pages 10 and 11 of the brief and pages 5 and 6 of the reply brief, appellants assert that there is no motivation to combine the references as asserted by the examiner.

In response the examiner states, on page 4 of the answer, that Rizzo not Burge was relied upon to teach the limitation of automatically providing the identity of the buyer to the seller. On page 4 of the final Office action, the examiner states the that the term "identity" in claim 1 is interpreted as "a characteristic that identifies the buyer through a generic characteristic such as a file/ message identified for example as a Case ID and short description of the individual and their needs." Further, the examiner states, on pages 5 and 6 of the answer:

> Appellant did not define "identity" and thereby was provided an interpretation of the word "identity" used during examination. While the Appellant argues at page 8 and 9 that this is insufficient identity information for the agent/seller to directly contact a buyer, it [sic., it is] important to note that the teachings of Rizzo, which the definition applies are in line with the Appellants specification as well as the claim wording. For example, Figures 5 and 6 of the Appellant's specification disclose and teach one of ordinary skill that the seller is automatically sent an email - with no identifying information other than a link stating "3 New Leads." In turn, the seller/agent as taught by the Appellant's disclosure must "manually" move the cursor via the attached mouse and then "manually" click on the link in order to obtain the identity of the buyer. Rizzo discloses the same method of the seller being sent automatically an email with the identity (see Final Rejection definition page 4) of the buyer after it is matched to a suitable seller (see at least Abstract and Figure 5). In turn, the seller clicks on the link to obtain additional information on the needs of the identified buyer (see at least Abstract, Col 1, lines 54 - 57, Col 4, lines 12 - 21 and Figure 5). Therefore, Rizzo would teach one of ordinary skill a method for automatically providing the identity of the suitable buyer to the suitable agent without action from the agent (see at least Abstract, Col 1, lines 54 - 57, Col 4, lines 12 - 21 and Figures 4 and 5).

Finally, in response to the appellants' argument concerning the motivation to combine the references, the examiner asserts that the two references disclose the need for a more effective matching process and thus the modification further enhances the matching process.

We concur with the examiners determination that Rizzo discloses the claimed limitation of "automatically providing the identity of the suitable buyer to the suitable agent without action by the agent." Further, as discussed *infra,* we find that Rizzo discloses all of the limitations of claim 1; as such appellants' arguments concerning the motivation to modify the references are moot as anticipation is the epitome of obviousness. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). *See also In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). However, as our reviewing court has cautioned such a finding may constitute a new ground of rejection, s*ee In Re Meyer* 599 F2.d 1026, 1031, 202 U.S.P.Q. 175, 179 (CCPA 1979), we accordingly designate our decision as a new grounds of rejection.

Claim 1 recites the limitations of "providing the identity of the buyer to agents for sale of at least one of products or services" and "automatically providing the identity of the suitable buyer to the suitable agent without action from the agent." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification will not be read into the claims. *In re Etter,* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original). *In re Cruciferous Sprout Litigation,* 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing

Intervet America Inc v. Kee-Vet Laboratories Inc. , 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). Appellants' arguments in discussing Rizzo assert that it does not teach providing "the client's identity that would allow direct contact (name, email and phone number)." As the examiner states we find no definition in appellants' specification of the term "the identity of the suitable buyer." Nor does appellants' specification discuss the identity of the buyer provided to the user as being such that it allows direct contact (name, email and phone number). While the example depicted in appellants' Figure 6 provides support for a claim limitation of "providing the identity that *would allow direct contact (i.e. name, email and phone number)* of the buyer to agents for sale of at least one of products or services" the words in italic are not present in claim 1 and we decline to import such limitations into the claim. The examiner has found that within the scope of the claim, the term identity of the buyer is a characteristic that identifies the buyer; we find that this interpretation of the term is consistent with appellants' specification and concur with the examiner's claim interpretation.

Rizzo is directed to a system for matching clients (customers or buyers) with professional service providers. See abstract. The clients use a web browser to access a web page to enter data concerning the professional services they require. See flow chart Figure 1A, input display screen Figure 3 and column 3, lines 1 through 28. The system then checks the data for proper formatting and creates a unique identifier. The unique user identifier and the data are then stored in a database. See column 3, lines 45 through 58. Periodically the database is queried to identify service providers which meet the customers needs as identified in the data. See column 3, lines 59 through 63. The system automatically generates an e-mail to the service provider when there is a match. The e-mail includes much of the data entered by the customer. See column 4, lines 12-21. Although, Figure 1b, step 270 shows that the e-mail does not contain name, e-mail address and telephone number of the customer, the e-mail does contain the unique identifier and a link which leads to a web page which provides all of the data including name, e-mail address and phone number. See Figures 5 through 7.

We consider Rizzo's web page, through which a customer enters data, to describe appellants' claimed, "interactive environment ... relating to the ... services offered by agents." We consider the data received from the web page's interactive environment to describe appellants' claimed customer profile. We note that the customer responses to Rizzo's web page provide a direct inference of the criteria desired by the customer. Rizzo's disclosure of querying the database to find a match between the customer and the service provider describes appellants claimed step of comparing the profile of the customer with criteria of the service provider. We consider Rizzo's disclosure of automatically sending an e-mail with the unique identifier and a link, which leads to a web page with more detail about the customer, to describe appellants claimed step of "automatically providing the identity of the suitable buyer to the suitable agent without action from the agent." As discussed *supra* the term identity is not limited to just name, e-mail address and phone number. Further, even if such a limitation were present, as appellants state on page 5 of the reply brief "the claims recite that the identity of the buyer is automatically provided to the agent without action by the agent, not that the agent automatically receives the identity." Clearly, this is not the same as having to specifically request additional information which has then to be formulated and sent back to the seller, as is taught in Rizzo. Thus, we find that Rizzo does teach that the name of the customer is automatically provided to the service provider by the e-mail as the e-mail contains all of the information necessary for the service provider to determine the customer's name. Whether or not the service provider has to perform several steps to actually receive the name is beyond the scope of the claim.

For the forgoing reasons, we find that Rizzo anticipates claim 1. As anticipation is the epitome of obviousness, we sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103. Appellants has presented no arguments directed to claims 2 through 27, accordingly we group claims 2 through 27 with claim 1 and sustain the examiner's rejection of claims 2 through 27 for the reasons stated with respect to claim 1.

Conclusion

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED; 37 CFR § 41.50(b)

STUART S. LEVY
Administrative Patent Judge

ROBERT E. NAPPI
Administrative Patent Judge

ANTON W. FETTING
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BOARD OF PATENT APPEALS AND INTERFERENCES

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